Communication to Record Substance of Interview
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: August 28, 2008
Electronic Signature for Susan Pagano: /Susan Pagano/

Docket No.: 967_022
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hiroshi Miyawaki

Application No.: 10/031,138 Confirmation No.: 8211

Filed: May 2, 2002 Art Unit: 3694

For: INTERNET CHARGING SYSTEM Examiner: Brian E. Fertig

COMMUNICATION TO RECORD SUBSTANCE OF INTERVIEW

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Communication begins on page 2 of this paper.

COMMUNNICATION

A telephone interview was held on August 27, 2008 between Examiner Brian Fertig and applicant's representative Dmitry Andreev.

Applicant's representative began the interview by reading the following statement: "The interview will be focused on a limited number of issues for purposes of reducing the time of the interview, and for purposes of expediting an allowance. The focused nature of the interview will not be taken as an indication that arguments for unpatentability by the Examiner not discussed are conceded to be correct and appropriately made. Applicant expressly reserves the rights, later in prosecution of the present application or another application, to challenge the propriety of the outstanding office action on grounds not discussed in the interview."

Applicant's representative stated that the interview will be focused on claims 3, 5, 6, 11, and 12.

Applicant's representative further stated that in the Office Action of May 28, 2008, Claims 2-22 have been rejected under *35 U.S.C. § 103(a)* as being unpatentable over U.S. Patent No. 6,240,091 to Ginzboorg *et al.* ('Ginzboorg') in view of U.S. Patent No. 5,913,040 to Rakavy *et al.* ('Rakavy').

With respect to claim 3, applicant's representative asked the Examiner to identify where in the relied upon reference there is a teaching of an "information terminal [being] configured to automatically change a provider." The Examiner referred to the passages of Rakavy and Ginzboorg cited in the Office Action of May 28, 2008. Applicant's representative stated that Rakavy's teaching of multiple advertisement servers could not be analogized to the applicant's teaching of automatically selecting an Internet server provider (ISP), since an ISP provides network connectivity rather than content provided by an advertisement server. Applicant's representative further stated that while Ginzboorg discloses "several different access server providers … connected to a shared router R1,"[1] Ginzboorg does not teach the ability of an information terminal to

[1] U.S. Patent No. 6,240,091 Col. 6 liens 61-67 and Figs. 3c-3d

automatically change a provider. The Examiner suggested that the applicant include the argument in the response to the outstanding Office Action.

With respect to claim 5, applicant's representative stated that the applicant wishes to amend claim 5 to recite the ability of the customer to select a desired charging method information from the information in the transmitted charging table, wherein said charging method information includes advertisement size information. The applicant's representative stated that while Rakavy disclosed an advertisement information record including an advertisement size[2], neither Rakavy nor any other prior art reference of record taught the ability of the customer to select a charging method based on the size of displayed advertisements. The applicant's representative requested the Examiner's opinion on the allowability of claim 5 in the proposed amended form. The Examiner declined to comment on the claim allowability and suggested that the applicant include the proposed claim amendment and the argument in the response to the outstanding Office Action.

With respect to claim 6, applicant's representative stated that the applicant wishes to amend claim 6 to recite the ability of the customer to select a desired charging method information from the information in the transmitted charging table, wherein said charging method information includes the number of advertisements displayed on the information terminal. The applicant's representative stated that while Rakavy disclosed tracking which advertisements have been downloaded to the user[3], neither Rakavy nor any other prior art reference of record taught the ability of the customer to select a charging method based on the number of displayed advertisements. The applicant's representative requested the Examiner's opinion on the allowability of claim 6 in the proposed amended form. The Examiner declined to comment on the claim allowability and suggested that the applicant include the proposed claim amendment and the argument in the response to the outstanding Office Action.

[2] U.s. PATENT No. 5,913,040 Col. 7, lines 15-18
[3] U.S. Patent No. 5,913,040 Col. 5 lines 40-41

With respect to claim 11, applicant's representative asked the Examiner to identify where in the relied upon reference there is a teaching of a "charging table [having] communication traffic state information concerning a communication traffic state in the public network." The Examiner referred to the passages of Ginzboorg cited in the Office Action of May 28, 2008. The applicant's representative stated that the passage of Ginzboorg relied upon by the Examiner in the outstanding office action disclosed a charging server sending an OK message to the access server[4] in response to the charging server storing an accepted contract charging record (CDR) in the charging database, and is absolutely silent as to the communication traffic state in the public network. The Examiner disagreed stating that the charging record was an indication that it was OK for the user to access the public network. The applicant's representative stated that such a line of reasoning would be an attempt to assert an inherency argument, for which the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.[5]

Furthermore, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.[6] Moreover, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.[7] The Examiner agreed with respect to the legal requirements to an inherency argument, but stated that for an obviousness rejection, an inherency argument is not even needed, since in the Examiner's opinion, a suggestion or motivation would suffice.

With respect to claim 12, applicant's representative asked the Examiner to identify where in the relied upon reference there is a teaching of an "charging table

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[4] U.S. Patent 6,240,091 Col. 9 lines 50-55
[5] *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) cited in *MPEP §2112*
[6] *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) cited in *MPEP §2112*
[7] *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) cited in *MPEP §2112*.

[having] communication electronic commerce deal amount/frequency information." The applicant's representative stated the prior art of record is absolutely silent as to the electronic commerce. ." The Examiner referred to the passages of Ginzboorg cited in the Office Action of May 28, 2008. The applicant's representative stated that even if the Examiner's view of Ginzboorg disclosing "information about the frequency and content of all of a users [*sic!*] interaction with the Internet"[8] were true, Ginzboorg fails to teach or even suggest at least the terminal being configured to allow the customer to select a desired charging method based on electronic commerce deal amount and frequency.

Accordingly, in view of the above amendments and remarks, applicant believes the present application to be in condition for allowance.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: August 28, 2008

Respectfully submitted,

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[8] Office Action of May 28, 2008, page 15